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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,058	11/26/2003	Michael Roberts	NECW 20.768	8639
26304	7590	03/08/2007	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			FIGUEROA, MARISOL	
			ART UNIT	PAPER NUMBER
			2617	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/08/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/723,058	ROBERTS, MICHAEL
	Examiner Marisol Figueroa	Art Unit 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 29 December 2006.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

### **DETAILED ACTION**

1. This action is in response to Applicant's amendment filed on 12/29/2006. Claims 1-7 are pending in the present application. The rejections not addressed below have been withdrawn.

#### ***Response to Arguments***

2. Applicant's arguments filed on 12/29/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (see page 7, line 3 – page 8, lines 1-2 of applicant's remarks), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references (see page 8, lines 3-18 of applicant's remarks), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references are in the same field of endeavor of mobile assisted handoff comprising signal quality measuring of cells. As stated in the previous action

the use of measuring and reporting the quality levels of each of the cells assigned to mobile terminal is conventional and well known in the art.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over LAITINEN et al. (US 2003/0189912 A1) in view of KALLIN et al. (US 5,701,585).

**Regarding claim 1**, Laitinen discloses a method of handover in a multimode mobile telecommunication network (P.0005, lines 1-6) in which, to initiate a handover, the network sends to a mobile terminal a first group of system information via a first channel associated with circuit switching services and a second group of system information via a second channel associated with packet switching services (P.0025; a dual-mode MS receives information of 3G neighbor Cell list in a SI2quater message from the BCCH channel and a PSI3quarter message on the PBCCH channel), comprising the steps of:

a) performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information (P.0026, P.0058, lines 1-10; the mobile station receives information from the network over the PBCCH and construct a Neighbor Cell list and measures the cells contained in the list);

b) sending to the network the measurements performed in step a) (P.0058, lines 1-10; the MS reports the measurements to the network), and

e) initiating the procedure of handover according to the measurements performed in step a) (P.0005, lines 1-6; P.0019; the wireless network commands to the MS to perform handover if necessary).

Furthermore, Laitinen discloses wherein the network sends to the mobile terminal the first group of system information via the first channel after the performing measurements operation (P.0006-0007; P.0008, lines 1-6; P.0011; P.0022, lines 1-5; P.0025; when the mobile station transitions from a GPRS dedicated mode to a GSM dedicated mode, the MS immediately made measurements on packet system information (PSI3) received while in GPRS dedicated mode, then while the MS is in GSM dedicated mode, it receives system information (SI2) via a BCCH, i.e. first channel, corresponding to a first group of system information).

Laitinen does not expressly disclose the features of c) further performing measurements at least in one further neighboring cell on the basis of the information contained in the second group of system information, and further sending to the network the measurements performed in step c), the further sending operation being performed in a message distinct from the sending step.

However, Kallin teaches a mobile assisted handoff for use in a cellular communication system in which the mobile station receives or is assigned a list of cells and measures the quality level of each assigned cell and regularly reports the measurements (i.e., different measurement reports) to the communication system. Also, teaches that a mobile station cannot measure all of the neighboring cells at the same time and if a good handoff candidate is not found the mobile station can perform further measurements until a good candidate handoff is found (col. 1, line 54-col. 2, lines 1-16; col. 3, line 67-col. 4, lines 1-30; col. 5, lines 14-44).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, the features of step c) further performing measurements at least in one further neighboring cell on the basis of in the second group of system information, and further sending to the network the measurements performed in step c), the further sending being performed in a message distinct from the sending of step B), as suggested by Kallin, because it is conventionally well known that in a mobile assisted handoff (as used in Laitinen) a mobile terminal regularly measure and reports (i.e., distinct messages) the quality level of each of the cells assigned to the mobile terminal in order to find a good candidate for handoff.

**Regarding claim 2**, the combination of Laitinen and Kallin disclose the method according to claim 1, Laitinen discloses wherein the measurements in a neighboring cell based on information contained in the first group of system information associated with circuit switching services (P.0005, lines 1-4; P.0006, lines 10-17; in the GSM dedicated mode, i.e. circuit switched connection, the MS receives system information (SI2), corresponding to a first group of system information, over a BCCH channel).

**Regarding claim 3**, the combination of Laitinen and Kallin disclose the method according to claim 2, Laitinen discloses wherein the telecommunication network is a GSM/GPRS network (P.0019; it is inherent to recognize that the telecommunication network is a GSM/GPRS network since the MS is dual mode GSM/UMTS and compatible with a GPRS network), and wherein the first channel is a BCCH channel and the second channel is a PBCCH channel (P.0025; the MS receives a SI2quarter message from a BCCH channel and a PSI3quarter message from a PBCCH channel).

**Regarding claim 4**, the combination of Laitinen and Kallin disclose the method according to claim 2, Laitinen discloses wherein the telecommunication network is a UMTS network (P.0019,

lines 1-3; it is inherent to recognize that the telecommunication network is also a UMTS network because the MS station is a dual mode terminal compatible with a multimode network, i.e. GSM, GPRS, and UMTS).

**Regarding claim 5**, Laitinen discloses a mobile terminal used in a multimode mobile telecommunication network (P.0019, lines 1-3), the mobile terminal performing measurements for preparing for a handover in the network, the measurements depending either on a first group of system information sent by the network to the mobile terminal via a circuit switching channel or on a second group of system information sent by the network to the mobile terminal via a packet switching channel, the mobile terminal comprising:

means for performing measurements at least in one neighboring cell on a basis of information contained in the second group of system information, means for sending to the network the measurements performed (P.0058, lines 1-10; it is inherent to recognize that the mobile terminal has means for performing measurements of cells and means for sending these measurements to the network since it performs these procedures), and

means for initiating the procedure of handover according to the measurements performed (P.0005, lines 1-6; the MS measures and send the reports of measurements to the network and this enables the network to command a handover if it is determine from the measurements that a handover is necessary).

Furthermore, Laitinen discloses wherein the network sends to the mobile terminal the first group of system information via the first channel after the performing measurements operation (P.0006-0007; P.0008, lines 1-6; P.0011; P.0022, lines 1-5; P.0025; when the mobile station transitions from a GPRS dedicated mode to a GSM dedicated mode, the MS immediately made measurements on packet system information (PSI3) received while in GPRS dedicated mode, then while the MS is

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in GSM dedicated mode, it receives system information (SI2) via a BCCH, i.e. first channel, corresponding to a first group of system information).

Laitinen does not expressly disclose wherein the mobile terminal comprises further means for performing further measurements at least in one further neighboring cell on the basis of information contained in the second group of system information, further means for sending to the network the further measurements performed, wherein the further measurements are sent in a message distinct from the sending of the measurements.

However, Kallin teaches a mobile assisted handoff for use in a cellular communication system in which the mobile station receives or is assigned a list of cells and measures the quality level of each assigned cell and regularly reports the measurements (i.e., different measurement reports) to the communication system. Also, teaches that a mobile station cannot measure all of the neighboring cells at the same time and if a good handoff candidate is not found the mobile station can perform further measurements until a good candidate handoff is found (col. 1, line 54-col. 2, lines 1-16; col. 3, line 67-col. 4, lines 1-30; col. 5, lines 14-44).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, wherein the mobile terminal comprises further means for performing further measurements at least in one further neighboring cell on the basis of information contained in the second group of system information, further means for sending to the network the further measurements performed, wherein the further measurements are sent in a message distinct from the sending of the measurements, as suggested by Kallin, because it is conventionally well known that in a mobile assisted handoff (as used in Laitinen) a mobile terminal regularly measure and reports (i.e., distinct messages) the quality level of each of the cells assigned to the mobile terminal in order to find a good candidate for handoff.

**Regarding claim 6**, the combination of Laitinen and Kallin disclose the method according to claim 1, Laitinen discloses wherein the means for performing measurements step is performed the measurements immediately upon receipt of the second group of system information (P.0058; the MS immediately perform measurements on system information received over the PBCCH when enters the GSM dedicated mode).

**Regarding claim 7**, the combination of Laitinen and Kallin Laitinen disclose the mobile terminal according to claim 5, Laitinen discloses wherein the means for performing measurements is adapted to perform the measurements immediately upon receipt of the second group of system information (P.0058; the MS immediately perform measurements on system information received over the PBCCH when enters the GSM dedicated mode).

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marisol Figueroa whose telephone number is (571) 272-7840. The examiner can normally be reached on Monday Thru Friday 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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